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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,680	09/28/2001	James R. Hornsby	6881.03	5486
7590	07/13/2004		EXAMINER	
LAW OFFICE OF RICHARD B. KLAR 875 AVENUE OF THE AMERICAS SUITE 2301 NEW YORK, NY 10001			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

YW

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/966,680	HORNSBY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dmitry Suhol	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 22-38 is/are pending in the application.
- 4a) Of the above claim(s) 28-31 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 22-27 and 32-38 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22-27 and 32-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-10, 12-13, 16-21, 24-31, 33-38, 40-49 of copending Application No. 09/931570 in view of Tachau et al (U.S. Patent No. 6,346,025). Copending application no. 09/931570 discloses all of the elements of the claims but for armor configured to be attachable to the body, the device being transformable and a launch mechanism and launchable element. However Tachau discloses an amusement device, which teaches armor detachably carried by the body (figure 8), a device that is transformable (col. 19, lines 32-37) comprising a launchable element and launch mechanism (col. 4, lines 28-33).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 22-27 and 32-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-39 of copending Application No. 10/071545. Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth subject matters which are obvious over each other and only differ in breadth of terminology used. For example "features carried by the body" of the application is an obvious variation in meaning of the limitation "at least two transport elements moveably connected to the body; at least two arms moveably connected to the body" in the copending application 10/071545 because they are disclosed as the same feature.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Wooley et al '791. Wooley discloses a device containing all of the elements of the claims including, a body (figure 1) as required by claim 22, features carried by the body (elements 60, 50, 70, 370) as required by claim 22, means for powering the device (col.

2, lines 37-38) carried by the body (figure 1, compartment 30) as required by claim 22, a swipe card reader (col. 3, lines 31-40) as required by claim 22, a microprocessor operably coupled to the means for powering the device (260) as required by claim 22. An information card, as required by claim 23, is shown in figure 2 along with card game and actuation information (130a-130h and 170).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-23 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al '223 in view of Wooley et al '791. Li discloses an amusement device containing all of the elements of the claims including a body (fig. 20, element A) as required by claims 22 and 37, features carried by a body (movable elements coupled to a motor described in col. 7, lines 50-64) (fig. 20, elements B) as required by claim 22, a means for powering a device and some features carried by the body (col. 4, lines 22-26) as required by claim 22, a card reader carried by the body (data card reader and col. 7, lines 59-64 and fig. 20, element 210) as required by claim 22 and 37, a microprocessor operably coupled to a means for powering, a card reader and motor (fig. 17, element 25 and col. 5, lines 21-23) as required by claims 22 and 37. An information card, as required by claim 23, is shown in figure 1 as element 10 and described in col.

7, lines 59-64 with the card game information and device actuation information shown in figure 1 as picture information and data information 12. A motor associated with the body, as required by claim 37, is shown as element 62 in figure 20. At least two movable elements, as required by claim 37, are shown as elements (B) where it is considered that the arms or legs of the device are reconfigurable to a different position in which case the device is transformed. At least two couplings, as required by claim 38, are inherent in the device since without the coupling the movable elements would not be retained on the body nor would they be movable as intended (col. 7, lines 50-56).

Li lacks a teaching of a card reader being of a swipe card type. However, Wooley discloses a swipe card reader used to synthesize commands for generating speech or sound in a variety of devices including games (col. 1, lines 25-31 and col. 2, lines 3-7). Therefore it would have been obvious to incorporate a swipe card reader for the card reader of Li for the purpose of providing an improved data storage and retrieval system which controls voice or sound synthesizer, especially since one of the uses of the cards of Li is for the generation of sound.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al '223 and Wooley et al '791, as stated above, and further in view of Mowrer et al '716. Li, as modified by Wooley, fails to explicitly teach armor configured to be attachable to a body, as required by claim 24. However, Mowrer discloses a sound producing amusement device which can be embodied as any type of figure which teaches that it is known to provide armor which is attachable to the body of the device (col. 2, lines 61-

63). Therefore it would have been obvious to incorporate armor attachable to a body portion with the device of Li, as modified by Wooley, for the purpose of adding a variety of ornamental surface details and interest to the user.

Claims 27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ketty et al '424 in view of Broadfield (WO 95/30973). Ketty discloses an amusement device containing most of the elements of the claims including, a body (11) as required by claim 27 and 36, a launchable element associated with the body (balls 28) as required by claim 27 and 36, a launch mechanism associated with the body (col. 4, lines 35-41) as required by claim 27 and 36, a motor (read onto the spring loaded actuating mechanism of the launcher as described in col. 4, lines 35-41) as required by claim 27 and 36.

Ketty fails to explicitly teach a swipe card reader as required by claim 27 and 36. However, Broadfield discloses an amusement device which teaches that it is known to employ a card swipe reader to facilitate a financial transaction through a credit card (see abstract and 1<sup>st</sup> paragraph at page 2). Therefore it would have been obvious to employ a card swipe reader in the device of Ketty for the purpose of allowing a quick and easy financial transaction.

### ***Conclusion***

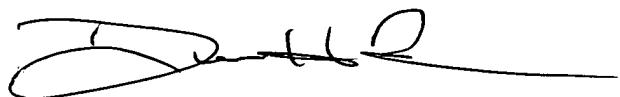
Art Unit: 3712

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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